

REMARKS

Claims 1-4, 29, 30, 32, 33 and 39-41 are pending in the application.

Claim 31 has been canceled, without prejudice.

I. **ALLOWABLE SUBJECT MATTER**

The allowance of Claim 29 is noted with appreciation. Also noted with appreciation is the indication that Claims 40 and 41 are directed to allowable subject matter. Applicant has deferred rewriting Claims 40 and 41 in independent form pending Examiner's consideration of this paper.

II. **REJECTION UNDER 35 U.S.C. §102**

Claim 30 was rejected under 35 U.S.C. §102(b) as being anticipated by FARRIS (U.S. Patent No. 5,541, 917, hereinafter referred to as Farris). Claims 31-33 were rejected under 35 U.S.C. § 102(e) as being anticipated by GERSZBERG, et al. (U.S. Patent No. 6,229,810, hereinafter referred to as Gerszberg). The rejections are respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Claim 30 is directed to a computer readable medium which, when loaded into a processor connected to a data network to which at least one telephone is also connected, controls the processor to establish a voice call based on user input messages from the telephone. Claim 30 also recites that the computer readable medium controls the processor to set up at least one non-telephony data service between the telephone and at least one data source based on one or more user input messages from the telephone received during pendency of the voice call.

The Office Action supports the anticipation rejection of Claim 30 based on Farris by citing lines 28-51 of Farris column 6. This passage of Farris indicates that trigger events can be detected during processing of voice telephone calls. However, the mere detection of a trigger event during processing of a voice call clearly does not meet the aforementioned Claim 30 limitation of setting up a non-telephony data service for the telephone, much less doing so based on a user input message from the telephone, much less a user input message received during pendency of the voice call.

Applicant has carefully reviewed the Farris reference, and has identified the following passages of Farris which relate to voice calls: line 59 of column 24 through line 29 of column 25; and lines 1-16 of column 26. These passages indicate that the aforementioned Farris trigger detection is actually just a part of the process of establishing the voice call. There is no teaching that a non-telephony data service is set up for the telephone based on a user input message received from the telephone during pendency of an established voice call. Farris therefore does not anticipate the invention recited in Claim 30.

Accordingly, the Applicant respectfully requests that the Examiner withdraw the §102(b) rejection of Claim 30.

Claims 32 and 33 are directed to a network intelligence for a data network. A call service provider facilitates provision of telephony services for a plurality of telephones. A control messenger can selectively send respective control messages which respectively enable and disable the ability of a user input element of a given telephone to locally control a function at that telephone. The Office Action alleges that the controller 100 of Gerszberg FIGURE 2 anticipates the aforementioned control messenger limitation of Claims 32 and 33, citing line 45 of Gerszberg column 7 through line 23 of Gerszberg column 8. The cited portion of Gerszberg teaches that a user may select services by local operation of a user device. The mere capability of a user selecting services locally by operation of a user device clearly does not meet the aforementioned control messenger limitation of Claims 32 and 33, wherein the control messenger can selectively send respective control messages which respectively enable and disable the ability of a user input element of a given telephone to locally control a function at that telephone.

Accordingly, the Applicant respectfully requests that the Examiner withdraw the § 102(e) rejection of Claims 32 and 33 (Claim 31 has been canceled, without prejudice).

III. REJECTION UNDER 35 U.S.C. § 103

Claims 1-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerszberg, in view of MOSS, et al (U.S. Patent No. 5,485,370, hereinafter referred to as Moss). Claim 39 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gerszberg in view of

COOPER, et al (U.S. Patent No. 5,790,671, hereinafter referred to as Cooper). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second,

there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Claims 1-4 recite one or more terminal emulators, each of which includes at least one service proxy for setting up services between a plurality of data sources and a plurality of telephones. The pending Office Action correctly indicates that Gerszberg does not teach the recited terminal emulator including at least one service proxy. In support of the obviousness rejection, the Office Action relies on the terminal emulator disclosed in Moss. However, the only teaching of a terminal emulator found in Moss is that the user equipment such as shown at 1 in Moss FIGURE 10 or 104 in Moss FIGURES 11 and 12 can be a terminal emulator (see lines 35-42 of column 21, lines 14-22 of column 26 and lines 6-8 of column 28). Accordingly, even if it could be argued that a combination of the Moss teaching with the Gerszberg teaching would suggest that the Gerszberg user equipment could be a terminal emulator, the Office Action still alleges that the Gerszberg intelligent services director (ISD) 22 corresponds to the service proxy of Claims 1-4. So even the alleged combination of teachings of Moss and Gerszberg would not result in a terminal emulator that includes a service proxy as required by Claims 1-4. Gerszberg teaches that ISD 22 provides functionalities that are not included in the user equipment. Accordingly, even if the terminal emulator of Moss were substituted as a user equipment in Gerszberg, there is still no teaching or suggestion in Gerszberg or Moss that such terminal emulator would have any need to include any of the functionalities that are already provided for

the user equipment by the Gerszberg ISD 22.

Accordingly, the Applicant respectfully requests withdrawal of the §103(a) rejection of Claims 1-4.

Claim 39 is directed to a network intelligence for a data network, and recites a call service provider that facilitates provision of telephony services for a plurality of telephones. The call service provider includes a messenger for sending messages with audio parameters over the data network to the plurality of telephones for controlling audio at the plurality of telephones. The Office Action correctly indicates that Gerszberg does not teach the messenger recited in Claim 39. The Office Action relies on Cooper as a teaching for the use of control messages to transmit audio parameters for audio control at remote devices. However, Cooper relates merely to the transmission of audio parameters from a microprocessor 12 to a DSP 20, both of which are included within a single portable radio communication device as illustrated in Cooper FIGURE 1. Thus, Cooper teaches only that audio parameters are transmitted between data processing devices within a single portable radio communication device, which is clearly different from the Claim 39 limitation of a messenger for sending messages with audio parameters over a data network to a plurality of telephones for controlling audio at the plurality of telephones. In other words, any combination of the Cooper and Gerszberg teachings would, at most, result in the transfer of audio parameters internally within the individual user devices illustrated generally at 10 in Gerszberg FIGURE 1. Neither Gerszberg nor Cooper even remotely suggests that Gerszberg could be modified to send audio parameter messages over the data network 42 to the Gerszberg user devices.

Accordingly, the Applicant respectfully requests withdrawal of the §103(a) rejection of Claim 39.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the pending Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _____

11/15/2004

Robert D. McCutcheon

Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@davismunck.com*